

REMARKS

This amendment is being filed in response to the Office Action having a mailing date of December 28, 2004 (hereinafter “Office Action”). Claims 51, 53-61, 64, 66-69, 71-72, 75, 77, 80-85, 87-88, 91, 93, and 96-97 are amended as shown, and such amendments will be discussed in further detail below. Claims 50 and 79 are canceled herein without prejudice. No new matter has been added. With this amendment, claims 51-78 and 80-97 are pending in the application.

In the Office Action, claims 50-97 were rejected under 35 U.S.C. § 112, second paragraph for being indefinite. Claims 50-59, 64-68, 79-81, and 84 were rejected under 35 U.S.C. § 102(b) as being anticipated by Johnson (U.S. Patent No. 5,813,009). The applicants thank the Examiner for indicating that claims 60-63 and 82-83 would be allowable if rewritten to overcome the 35 U.S.C. § 112, second paragraph rejection(s) and to include the limitations of their respective base claims, since claims 60-63 and 82-83 contain allowable subject matter. The applicants further thank the Examiner for also indicating that claims 69-78 and 85-97 would be allowable if rewritten or amended to overcome the 35 U.S.C. § 112, second paragraph rejection(s), since claims 69-78 and 85-97 also contain allowable subject matter.

More specifically with regards to claims 60-63, 69-78, 82-83, and 85-87 that contain allowable subject matter, the Examiner stated that the feature(s) of “recursively extracting from a data structure having a plurality of electronic files provided from an external system and subject to a legal proceeding” are not disclosed or suggested by the prior art (Office Action, page 9). With regards to the 35 U.S.C. § 112, second paragraph rejection(s), the Examiner stated that it is “unclear as to what does the indexing or index metadata refer to” and “where the received electronic files and metadata are being stored” (Office Action, page 3).

Therefore, the applicants have amended the claims to overcome the Examiner’s rejections under 35 U.S.C. § 112, second paragraph. First, claim 60 has been rewritten in independent form to include the recitations of its base claim 50 (with claim 50 now canceled), and added recitations to specify “where the received electronic files and metadata are being stored.” The applicants have also eliminated the “indexing” previously recited in the claim. In particular, as requested by the Examiner, the following italicized recitations that pertain to the

specific storage location(s) provided in newly independent claim 60 and citations to the applicants' disclosure (hereinafter "Application"), where example corresponding features are described, are identified in the parentheticals below that follow the quoted italicized claim language:

- "*storing the recursively extracted electronic files in a searchable format in a first server unit using, including storing textual content of the recursively extracted electronic files in the searchable format in the first server unit*" (See, e.g., Application page 11, lines 19-22; page 12, lines 7-12; page 13, lines 3-5 and 11-13; page 20, lines 1-5; and Figures 1-3).
- "*obtaining the metadata from each of the recursively extracted electronic files, and storing the metadata in a second server unit in a manner that preserves directory structure information of the received data structure*" (See, e.g., Application page 12, line 25 through page 13, line 3; page 13, lines 15-18; and page 19, lines 6-10. See, e.g., Application page 15, line 26 through page 16, line 4; and page 16, lines 20-25).
- "*converting the recursively extracted electronic files to a read-only format, and storing the electronic files in the read-only format in a third server unit*" (See, e.g., Application page 12, line 25 through page 13, line 1; page 13, lines 9-11; page 18, lines 9-20; and Figures 2-3).

Based on the above and other recitations contained in newly independent claim 60, claim 60 is now allowable under 35 U.S.C. § 112, second paragraph and also allowable over the cited references as indicated by the Examiner. Certain dependent claims that depended directly or indirectly on claim 50 are amended to change their dependency to newly independent claim 60, are amended to specifically recite storing in the first, second, or third server units as

appropriate, and/or are amended to be consistent with the recitations of newly independent claim 60. These dependent claims are now also allowable.

Independent claim 69 is amended to address the Examiner's 35 U.S.C. § 112, second paragraph rejection by reciting "where the received electronic files and metadata are being stored" and to remove references to "indexing." The following citations to the Application pertain to example storage of electronic files and metadata: *See, e.g.*, Application page 11, lines 19-22; page 12, lines 7-12; page 13, lines 3-5 and 11-13; page 20, lines 1-5; and Figures 1-3. *See, e.g.*, Application page 12, line 25 through page 13, line 3; page 13, lines 15-18; and page 19, lines 6-10. *See, e.g.*, Application page 15, line 26 through page 16, line 4. *See, e.g.*, Application page 12, line 25 through page 13, line 1; page 13, lines 9-11; page 18, lines 9-20; and Figures 2-3.

Accordingly, independent claim 69 is now in allowable form. Certain dependent claims that depend directly or indirectly on independent claim 69 are amended to recite the specific storage locations or to otherwise make their recitations consistent with amended independent claim 69. These and other dependent claims that depend directly or indirectly on independent claim 69 are now also allowable.

Independent claim 75 is amended to address the Examiner's 35 U.S.C. § 112, second paragraph rejection by reciting "where the received electronic files and metadata are being stored" and to remove references to "indexing." Independent claim 75 is thus now also allowable under 35 U.S.C. § 112, second paragraph (as well as being allowable over the cited references). The following citations to the Application pertain to example storage of electronic files and metadata: *See, e.g.*, Application page 11, lines 19-22; page 12, lines 7-12; page 13, lines 3-5 and 11-13; page 20, lines 1-5; and Figures 1-3. *See, e.g.*, Application page 12, line 25 through page 13, line 3; page 13, lines 15-18; and page 19, lines 6-10. *See, e.g.*, Application page 15, line 26 through page 16, line 4. *See, e.g.*, Application page 12, line 25 through page 13, line 1; page 13, lines 9-11; page 18, lines 9-20; and Figures 2-3.

Dependent claim 77 is amended to recite the specific storage locations or to otherwise make its recitations consistent with amended independent claim 75. Claim 77 and the

other dependent claims that depend directly or indirectly on independent claim 75 are now also allowable.

Claim 82 has been rewritten in independent form to include the recitations of its base independent claim 79, with independent claim 79 now canceled. Other amendments have been added to newly independent claim 82 to address the Examiner's 35 U.S.C. § 112, second paragraph rejection by reciting "where the received electronic files and metadata are being stored" (*i.e.*, the first, second, and third server units) and to remove references to "indexing." Claim 82 thus is now allowable under 35 U.S.C. § 112, second paragraph (as well as being allowable over the cited references). The following citations to the Application pertain to example storage of electronic files and metadata: *See, e.g.*, Application page 11, lines 19-22; page 12, lines 7-12; page 13, lines 3-5 and 11-13; page 20, lines 1-5; and Figures 1-3. *See, e.g.*, Application page 12, line 25 through page 13, line 3; page 13, lines 15-18; and page 19, lines 6-10. *See, e.g.*, Application page 15, line 26 through page 16, line 4. *See, e.g.*, Application page 12, line 25 through page 13, line 1; page 13, lines 9-11; page 18, lines 9-20; and Figures 2-3.

Dependent claims 80-81 and 83-84 that were previously dependent on independent claim 79 are amended to change their dependency to newly independent claim 82, are amended to specifically recite storing in the first, second, or third server units, and/or are otherwise amended as appropriate so as to be consistent with the recitations of newly independent claim 82. These dependent claims that depend directly or indirectly on newly independent claim 82 are in allowable form.

Independent claim 85 is amended to recite the conversion engine, and more specifically to recite "a conversion engine to convert the recursively extracted electronic files to a searchable format, and to obtain metadata associated with the received electronic files." The applicant notes that the first and second server units were already recited in independent claim 85 prior to the present amendment, and thus, independent claim 85 already recites "where the received electronic files and the metadata are being stored." The following citations to the Application pertain to an example conversion engine and example storage of electronic files and metadata: *See, e.g.*, Application page 11, lines 19-22; page 12, lines 7-12 and page 12, line 25 through page 13, line 1; page 13, lines 3-5 and 11-13; page 20, lines 1-5; and Figures 1-3. *See,*

e.g., Application page 12, line 25 through page 13, line 3; page 13, lines 15-18; and page 19, lines 6-10. *See, e.g.*, Application page 15, line 26 through page 16, line 4.

Further amendments are made to independent claim 85 to clarify the coupling or other communication between the conversion engine and the first and second server units. Examples of this coupling or other communication or interaction is described in the applicants' specification with regards to Figures 2-3, which show the server units 202 and 204 receiving data from the conversion engine 134.

Accordingly, independent claim 85 is now allowable. Certain dependent claims that depend directly or indirectly on independent claim 85 are amended to make their recitations consistent with amended independent claim 85. These and other dependent claims that depend directly or indirectly on independent claim 85 are also now allowable.

None of the references alone, or in any motivated combination, teach, motivate, or suggest one or more aspects that are recited in independent claims 60, 69, 75, 82, and 85. Thus, given the above amendments and accompanying remarks, the independent claims are now in condition for allowance. The dependent claims that depend directly or indirectly from these independent claims are likewise allowable for at least the same reasons, because they incorporate these aspects. In addition, many of the dependent claims recite additional aspects that are not taught, suggested, or motivated by the cited references.

Substance of the Interview

The Interview Summary form attached to the present Office Action stated that the reply to the Office Action must include the substance of the telephonic interview that was conducted between applicants' attorneys (Dennis M. de Guzman and Ellen M. Bierman) and Examiners Susan Y. Chen and Uyen Le on December 8, 2004. The substance of the interview is provided herein as follows:

The applicants' attorneys began by describing (using a hypothetical example) the nature in which two parties may find themselves in a lawsuit against each other. The process involved in filing and progressing through the lawsuit was described, and in particular the

discovery process in which each party is judicially compelled to produce documents (including electronic files) in response to discovery requests.

The applicants' attorneys then explained the problems of the prior art, namely, the difficulty in reviewing and otherwise processing the voluminous number of hardcopy documents that are produced by the parties in response to the discovery requests. In this context, the applicants' attorneys then described example embodiments of the applicants' invention that address these problems. More specifically, the applicants' attorneys directed the Examiners' attention to Figures 1-3 of the present application, and described the system and process in which electronic files were produced in response to discovery requests, extracted from data structures, loaded into different storage media (*e.g.*, three storage media shown in Figure 2 to respectively store indexed text, metadata, and read-only files), and then made available for searching.

The applicants' attorneys and Examiners Chen and Le discussed certain aspects of the above system and process(es), and in particular the role of a conversion engine 134 and the recursion process used to extract the electronic files from the original data structures and yet maintain structural information. The recitations of claim 50 were discussed in the exemplary context of the role of the conversion engine 134, but the applicants' attorneys and Examiners Chen and Le were unable to reach an agreement as to the specific language.

The applicants' attorneys and Examiners Chen and Le were not able to reach an agreement with regards to other issues pertaining to the patentability of the claims before the interview concluded. Moreover, the interview concluded before both parties had an opportunity to discuss the previously cited references (in particular U.S. Patent No. 6,332,154 to Beck) in detail.

Conclusion

With the filing of the present amendment, all of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

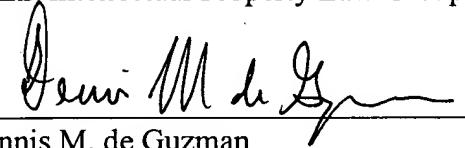
If applicants' representatives have overlooked a teaching in any of the cited references that is relevant to the allowability of the claims, the Examiner is requested to

specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the applicants' representatives at (206) 622-4900.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

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